

REMARKS/ARGUMENTS

Office Action Summary

The Office Action Summary, Disposition of Claims, 4a), states:

"Of the above claim(s) 12-25 and 27-30 are withdrawn from consideration."

Page 2, first paragraph of the Office Action states:

"Claims 12-25, and 27-29 are withdrawn from further consideration...."

Applicants elected to prosecute invention I, Claims 1-11, 26, 30 and 31. Therefore, Claim 30 is not withdrawn from consideration.

Claim Rejections 35 USC 112

35 USC 112, first and second paragraphs

Claims 1-3, 5-11, 26, 30 and 31 have been amended to comply with the requirements of 35 USC 112, first and second paragraphs by deleting "polyester/polyether" and inserting —polyester or polyether--.

35 USC 112, second paragraphs

Claims 2, 3 and 5-10 have been amended to comply with the requirements of 35 USC 112, second paragraph by inserting the phrase "the group consisting of" after the phrase "selected from."

Claim 11 does not contain a Markush language.

Claims 9-11 have been canceled.

Double Patenting Rejection

Claims 1-3, 5-11, 26, 30 and 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 16-18, 28, 31 and 32 of Application No. 10/007,518 (now U.S. Patent 6,555,628). The Office Action states that although the conflicting claims are not identical, they are not patentably distinct from each other because the controlled conversion epoxy resin of Application No. 10/007,518 is derived from identical reactants of an epoxy resin such as diglycidyl ether or ester, dihydric phenol such as bisphenol A (i.e. the 4,4'-

isopropylidene bisphenol of Claim 5, and an anhydride such as phthalic anhydride of Claim 6. This rejection is respectfully traversed for the following reasons.

Claims 1-3, 5-11, 26, 30 and 31 recite epoxy or phenolic functional polyester/polyether oligomer or polymer having an epoxy or phenolic functionality of greater than 2 and comprising moieties derived from (1) diglycidyl ethers or diglycidyl esters, (2) anhydrides and (3) dihydric phenols. The moieties are derived from three compounds.

On the other hand, claims 1-7, 16-18, 28, 31 and 32 of Application No. 10/007,518 (now U.S. Patent 6,555,628) recite a controlled conversion epoxy resin comprising moieties derived from (1) an epoxy resin and (2) a dihydric phenol, an acid anhydride, or an amine. The moieties are derived from only two compounds:

- (1) epoxy resin and (2) dihydric phenol
- (1) epoxy resin and (2) acid anhydride or
- (1) epoxy resin and (2) amine

Application No. 10/007,518 (now U.S. Patent 6,555,628) does not teach or suggest moieties derived from three compounds, as required in Claims 1-3, 5-11, 26, 30 and 31 of the present patent application.

Conclusion

In view of the above amendments and remarks, the claims are now in condition for allowance and a Notice of Allowance of Claims 1-3, 5-8, 26, and 30-32 is respectfully requested.

Respectfully submitted,



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